

REMARKS

Claims 1-34 are present in the above-captioned application and have been subjected to restriction under 35 U.S.C. § 121 (37 C.F.R. § 1.142). Specifically, the Official Action avers the following inventions are present in the claims:

Group I, Claims 1-22, drawn to package, classified in class 206, subclass 363.

Group II, Claims 23-34, drawn to a method of packaging a coil of fiberoptic cable classified in class 53, subclass unknown.

In support of the present restriction requirement, the Examiner alleged that the subject matter defined by the claims of the present invention represents two distinct inventions stating that:

"Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as retaining the fiber optic cable by snap fitting to the retainer instead of mounting. Also, insert the fiber optic coil carrier into the packaging tray before retaining the fiber optic cable onto the carrier.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper".

However, pursuant to 37 C.F.R. § 1.111, Applicants hereby traverse the restriction

requirement and request reconsideration thereof in view of the following remarks.

Initially, the basis and reasoning behind the restriction are faulty and illogical.

The restriction alleges that “the product as claimed can be made by another and materially different process.”

Initially, the product as specified by independent claim 1 is not made by the process as specified by independent method claim 23. Claim 23 specifies a method of packaging a coil of fiber optic cable, not a method of making the package of claim 1, and so this basis is prima facie not applicable to the fact situation of claims 1 and 23.

The restriction then continues, “such as retaining the fiber optic cable by snap fitting to the retainer instead of mounting”.

Independent product claim 1 never mentions the word “mounting” at all. Whereas independent process claim 23 specifies “mounting” which is considered to encompass “snap fitting”, so this basis is not applicable to independent product claim 1.

The last reason, “insert the fiber optic coil carrier into the packaging tray before retaining the fiber optic cable on to the carrier”, also does not apply to independent product claim 1, and only has some relevance to independent method claim 23.

Accordingly, all of the specific bases for the Restriction Requirement are logical and do not apply to product claim 1.

The Courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by

encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCA 1973) (emphasis added).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. § 121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations.

The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q.

2d 1436 (Fed. Cir. 1990) that court held that § 121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

These considerations indicate that the imposition of a restriction requirement can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

The particular reason given by the Examiner to justify restriction between Groups I, and II, are based on MPEP § 806.05(f). It is respectfully submitted that such a reason is insufficient to support this restriction requirement. In fact, reference to the Manual of Patent Examining Procedure does not establish compliance with the narrow statutory authorization for restriction requirements. The Manual simply states the policy of the Patent and Trademark Office without force of law; it is not authority for expanding or altering a statutory grant of authority.

The PTO can prescribe requirements in the MPEP, providing those requirements are not inconsistent with the statute, the rules or the case law of the PTO’s reviewing court. In re Ressola, 22 U.S.P.Q. 2d 1828, 1832 (Comm’r. PTO, 1992).

Reliance on the supposed classification of the groups of claims does not establish independence and distinctness. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct. The classification system is instead an aid in finding and searching for patents.

The classification system is not a good basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patens assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. § 121, which fact proves that basing restriction requirements on the classification system is improper.

For the reasons stated hereinabove, it is again respectfully urged that the Examiner withdraw the requirement for restriction and provide an action on the merits with respect to all

the claims. However, if the restriction requirement is maintained, applicants provisionally elect Group I, i.e., Claims 1-22.

Respectfully submitted,



William C. Roch
Registration No. 24,972

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

WCR/sf